

#### IV. REMARKS

Claims 1-11 and 13-15 are pending in this application. By this Amendment, the specification and claims 1-7, 9-10, 13 and 15 have been amended; and claim 12 has been cancelled. The above amendments are provided to facilitate early allowance of the claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, the specification is objected to because of an informality. By this Amendment, the specification has been revised according to the Office's suggestion. Accordingly, Applicants respectfully request withdrawal of the objection.

In the Office Action, the Office requests detailed information about the "IBM Recommendation Assistant Framework<sup>TM</sup>" because "it appears to be reasonably necessary to the examination of this application and cannot be found." (Office Action at page 2). Applicants respectfully submit that the IBM Recommendation Assistant Framework<sup>TM</sup> is used in the claimed invention only as a communication framework and thus is not necessary for an understanding or an examination of the claimed invention.

In the Office Action, claims 1-11 and 13-15 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. By the Amendment, claims 1, 9, 10 and 15 have been amended to be more clearly directed to statutory subject matter. For example, claims 1 and 9, as amended, are directed to a computer system, which is a statutory tangible thing. In addition,

claims 1 and 9, as amended, include "communicating the feedback to the users to assist the users in making decisions regarding a business transaction." Communicating a feedback to a user and assisting the user in making decisions regarding a business transaction can happen outside a computer and are not just the transformation of data within a computer. As such, communicating a feedback and assisting decision makings are physical activities and are practical applications as required by the Examination Guideline for Computer-Implemented Invention. 1184 OG at 92 (1996). Such activities affect the business transaction process and as a consequence create efficiency and productivity in the operation of the business transaction, which are "useful, concrete and tangible result[s]." State Street, 149 F.3d at 1373. With respect to claims 10 and 15, a tangible thing, e.g., "recordable data storage medium" (claim 10) is included. Accordingly, Applicants respectfully request withdrawal of the rejections.

In the Office Action, claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. By this Amendment, claim 10 has been amended according to the Office's suggestion. Accordingly, Applicants respectfully request withdrawal of the rejection.

In the Office Action, claims 1, 4-7 and 10-15 are rejected under 35 U.S.C. §102(e) as being anticipated by Mattern et al. (USPN 6,763,342), hereinafter "Mattern"; and claims 2-3 and 8-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mattern in view of Herz et al. (US Pub. No. 2001/0014868), hereinafter "Herz." Applicants respectfully submit that the claimed invention is allowable for at least the reasons stated below.

Applicants initially note that in the Office Action, claims 10-14 are rejected twice both under 35 U.S.C. §102(e) and under 35 U.S.C. §103(a). Applicants submit that those two grounds of rejection are inconsistent. Specifically, if a single reference, such as Mattern, teaches all the limitations of the claimed invention, the Office does not need to combine it with another reference, such as Herz. On the other hand, if the Office believes it is necessary to combine two references, a rejection under 35 U.S.C. §102(e) is not warranted. Applicants respectfully request clarification with respect to this inconsistency.

With regard to claims 1, 10 and 15, Applicants submit that Mattern does not disclose each and every claimed feature. For example, Mattern does not disclose, *inter alia*, "rules defined by the author to define links to other nodes in the graph based on a processing of user information including probabilistic reasoning [,]" as recited in claim 1 and incorporated in claims 10 and 15. Mattern discloses retrieving information from a decision path and providing a solution to a user. (See generally steps 504-518, cols. 11-12.) However, in Mattern, a link between a node and another node (or a sub-node) is not defined by rules in the node. Rather, the decision path of the knowledge module 208 (a tree structure of nodes) is built by the knowledge building component 230 (see col. 5, lines 18-20 of Mattern) and the links between the nodes of the decision path cannot be subsequently defined by a node in the decision path (tree structure). Mattern discloses that a user (of knowledge building component 230) might modify a decision path by "adding, moving, deleting, or altering nodes of the knowledge module 208 as represented in a tree structure[,]" but does not include defining a link by rules in a node. In Mattern, after a node is selected, the system only has the ability to follow one of the sub-nodes already linked (associated) to the selected node, but does not have the ability to define a link to the selected

node, as the current invention does. (See, e.g., col. 6, lines 29-30 of Mattern, “[each] question has one or more alternative replies associated with it.”)

In addition, in Mattern, the system cannot make a selection among alternative sub-nodes (e.g., relies to a question), and a user machine 204 is required to “identify one of the alternative replies corresponding to the root question node [so that] the knowledge module 208 is read to retrieve any subnodes (child nodes) corresponding to the selected reply.” (Col. 12, lines 7-10). In contrast, in the claimed invention, rules in a node define links to other nodes. Moreover, the claimed invention include defining links to other nodes “based on a processing of user information including probabilistic reasoning[.]” (Claim 1, incorporated in claims 10 and 15). Applicants submit that Mattern does not include this feature because a user machine is always required to make the selection in Mattern.

With further respect to claims 1, 10 and 15, Mattern does not disclose, *inter alia*, “a component to traverse the decision graph and fire the rules defined in the decision graph nodes[.]” In Mattern, as discussed above, a retrieval to a solution must follow the pre-determined tree structure (decision path), and if there are any forks (i.e., alternative replies), a user machine is required to make a selection. As such, in Mattern, there is no component of a computer system to traverse the decision path and to fire the rules. Actually, Mattern represents exactly the conventional approach that the claimed invention specifically identifies as disadvantageous and successfully avoids. (See specification of the claimed invention at page 2, lines 13-19.) In view of the foregoing, Mattern does not anticipate the current invention and Applicants respectfully request withdrawal of the rejections.

With respect to claim 9, the above arguments also apply. Applicants further submit that Herz does not overcome the above-identified deficiencies of Mattern. For example, the Office asserts that Herz discloses a weighting system (i.e., novelty control by adjusting the associated weights). (Office Action at page 9, citing Herz at paragraphs 0143-0146.) However, Herz does not use the weighting system to define links to other nodes, as the claimed invention does. Herz only uses the weighting system to control novelty.

Moreover, Applicants submit that there is no suggestion or motivation to combine Mattern and Herz. As discussed above, a retrieval of information in Mattern must follow the pre-determined tree structure, which can only be modified by a user of the knowledge building component 230. In Mattern, a user machine is required to make a selection among alternative sub-nodes, and a node cannot make such a selection itself. The Mattern system is not concerned with controlling "novelty" of the information retrieved and does not attempt (and is not expected) to interrupt a user machine's selection among alternative subnodes. As such, an adoption of the Herz teachings regarding controlling novelty by the weighting system will make Mattern unsatisfactory for its intended purpose, because such a "novelty control" interrupts a user machine's selection. In view of the foregoing, there is no suggestion or motivation to combine Mattern and Herz. Applicants submit that the Office obtains suggestion or motivation to combine only from the hindsight teachings of the currently claimed invention, which is not warranted. In view of the foregoing, the Office fails to establish a *prima facie* case of obviousness and Applicants respectfully request withdrawal of the rejections.

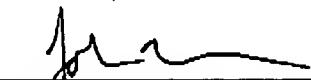
Applicants submit that all dependant claims are allowable for the reasons stated above, as well as for their own distinct features.

**V. CONCLUSION**

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

Date: 10/27/05

  
\_\_\_\_\_  
John A. Merecki  
Reg. No. 35,812

Hoffman, Warnick & D'Alessandro LLC  
75 State Street, 14th Floor  
Albany, New York 12207  
(518) 449-0044  
(518) 449-0047 (fax)